



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

COPY MAILED
NOV 13 2006
OFFICE OF PETITIONS

In re Application of :
Rowe et al. :
Application No. 09/786,253 : DECISION ON APPLICATION
Filed: August 15, 2001 : FOR PATENT TERM ADJUSTMENT
Attorney Docket Number: :
01-179 :
:

This is in response to the "REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT," filed April 7, 2006. Patentee requests that the patent term adjustment under 35 U.S.C. 154(b) set forth in the Issue Notification and on the cover of the above-identified patent be corrected from three hundred twenty-one (321) days to four hundred forty-one (441) days.

The request for reconsideration of patent term adjustment is DISMISSED.

Patentee is given two (2) months to respond to this decision. No extensions of time will be granted under 37 C.F.R. § 1.136(a).

On March 14, 2006, the above-identified application matured into U.S. Patent No. 7,011,826. The instant request for reconsideration, filed April 7, 2006 (Certificate of Mailing April 3, 2006), was timely filed within two (2) months of the date the patent issued. See § 1.705(d).

Patentee asserts that the paper filed November 14, 2005 was not an amendment under 37 CFR 1.312, but rather a letter regarding patent term adjustment filed pursuant to their duty of good faith and candor to the Office. As such, patentee maintains that, pursuant to 37 CFR § 1.705(e), the reduction of 120 days is improper.

§ 1.704(e) provides that:

Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

However, as stated in MPEP 2732,

Due to the time constraints on the Office under 35 U.S.C. 154(b)(1)(A)(iv) and (B) to complete its patent term adjustment determination and issue the patent, the Office must require applicants to follow the specific procedure set forth in 37 CFR 1.705 for requesting reconsideration of the Office's initial patent term adjustment determination and for requesting reinstatement of patent term adjustment reduced under 37 CFR 1.704(b). Thus, while submission of an application for patent term adjustment under 37 CFR 1.705(b) (regardless of whether it contains a request under 37 CFR 1.705(c) for reinstatement of reduced patent term adjustment) will interfere with the patent printing process, submission of the application will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under 37 CFR 1.704(c)(10). Other papers concerning patent term adjustment (e.g., status letters, untimely applications for patent term adjustment, requests for reconsideration of the Office's decisions on applications for patent term adjustment, petitions under 37 CFR 1.181, 1.182, or 1.183 concerning patent term adjustment, or miscellaneous letters concerning patent term adjustment), however, will be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under 37 CFR 1.704(c)(10).

A review of the record confirms that the paper filed November 14, 2005 is more properly characterized as a miscellaneous letter concerning patent term adjustment than as a letter regarding patent term adjustment pursuant to Comment 43 of the final rule. In their letter, applicants advise the Office of their agreement with the calculation of patent term adjustment and note that a terminal disclaimer was filed in the application (prior to the mailing of the notice of allowance and not under any circumstances that would warrant reduction of the patent term).

It is unnecessary for applicants to interfere with the patent printing process to advise the Office of their agreement with the patent term adjustment. Applicants should simply allow the patent to issue with the agreed patent term adjustment.

Likewise, it is unnecessary for applicants to interfere with the patent printing process to simply advise the Office that a terminal disclaimer was filed. The provisions of § 154(b), for adjustment due to examination delay, apply to original applications¹, other than designs, filed on or after May 29, 2000. The Office calculates patent term adjustment for examination delay in all eligible applications. In calculating the patent term adjustment, the Office does not differentiate between applications that have terminal disclaimers and those that do not. Nor does the Office undertake the burdensome task of reviewing every application with a terminal disclaimer to determine if the patent term adjustment accorded would adjust the term beyond the expiration date specified in the disclaimer.

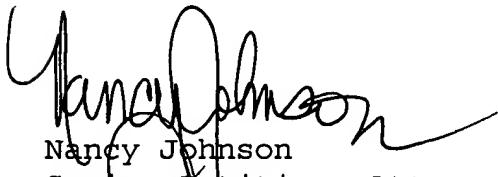
Rather, on issuance of the application, in compliance with 35 U.S.C. 154(b) and 37 CFR § 1.703(g), it is indicated in the patent that the patent term adjustment indicated therein is subject to any disclaimer. Moreover, it is also stated therein that the patent is subject to a terminal disclaimer.

Therefore, the Patent Term Adjustment was correctly reduced for the filing of this miscellaneous letter after the mailing of the notice of allowance.

In view thereof, the patent properly issued with a revised patent term adjustment of three hundred twenty-one (321) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions